

REMARKS

At the time of the Office Action, claims 1-42 were pending in the application. Claims 1-42 were rejected under a combination of 35 U.S.C. §§ 102(b) and 103(a) or under 35 U.S.C. § 103(a), alone. Claims 32-42 are hereby canceled, and new claims 43-53 have been added without the introduction of new material. Claims 1-31 and 43-53 are now pending in the application.

Rejection of Claims 1-7, 9, 11-22, 24 and 26-31 Under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1-7, 9, 11-22, 24 and 26-31 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over one or more of U.S. Patent No. 5,058,342 ("Crompton"), Japanese publication number JP 10-324762 ("JP 762"), Japanese publication number JP 2000-351881 ("JP 881"), and Japanese publication number JP 05-162224 ("JP 224"). Claim 1 is independent and claims 7, 9, and 11-15 depend from claim 1; claim 16 is independent and claims 17-22, 24 and 26-31.

Applicants recognize that a rejection under 35 U.S.C. §§ 102/103 may be made if appropriate as described in MPEP § 2112(III). However, MPEP § 2112(IV) provides the criteria that must be applied when rejecting a claim based on characteristics inherent in the prior art, including any rejection made in accordance with section 2112(III).

The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). . . . "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

MPEP § 2112(IV) (emphasis in original).

In rejecting claims 1 and 16, the Examiner states that,

Although [the reference] is silent with respect to the ASTM E-1354 properties for the noncombustible composition, absent evidence to the contrary [sic] it is examiner's position that [the reference] would inherently meet the claimed properties since it contains the same fire resistant components as those currently claimed, or alternatively, the presently claimed properties would obviously have been present in the [reference] product.

Office Action, pp. 3, 5, 6 and 7-8.

Applicant respectfully submits that the Examiner's position contradicts prior court decisions requiring the Examiner to show that "the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In fact, the specification of the current application clearly indicates that a composition containing the same fire resistant components would not necessarily meet the claimed properties. For example, paragraph 0030 discusses and Table 6 shows compositions containing the same fire resistant components but not meeting the claimed properties. The paragraph states that, "[T]he results demonstrate that the mere addition of a commercially-available fire-resistant additive [e.g., alumina tri-hydrate] to a traditional composite is inadequate to provide a composite that has fire-resistance properties to satisfy [the claimed properties]."

Applicant respectfully submits that none of the prior art references relied on by the Examiner disclose a composition that necessarily meets the claimed properties. Applicant also respectfully contends that the Examiner has made no showing that the claimed properties would obviously have been present in the prior art products. Accordingly, Applicant requests that the rejection of claims 1-7, 9, 11-22, 24 and 26-31 be withdrawn.

Rejection of Claims 8, 10, 23 and 25 Under 35 U.S.C. § 103(a)

Claims 8 and 23 were rejected under 35 U.S.C. § 103(a) as obvious over JP 881 in view of JP 762. Claims 10 and 25 were rejected under 35 U.S.C. § 103(a) as obvious over JP 881 in view of U.S. Published Application No. 2001/0018487 ("Itagaki"). Claims 8 and 10 depend from claim 1, and claims 23 and 25 depend from claim 16. Therefore, Applicant respectfully

submits that claims 8, 10, 23 and 25 are patentable for at least the reasons discussed above with regard to claims 1 and 16. Applicant requests that the rejection of claims 8, 10, 23 and 25 be withdrawn.

New Claims 43-52

For a discussion of the mechanical strength of embodiments of the invention, see paragraph 0049 and Table 14 of the specification. A discussion of fiber rich and resin rich surface layers can be found in the specification at paragraph 0027 and Table 4.

Conclusion

Applicants believe that all rejections and objections in the Office action have been addressed by the amendments and remarks above. If there are any questions regarding this Response, Applicants welcome a telephone call or interview with the undersigned Applicants' representative.

In the event that any fees are due, the Commissioner is authorized to debit those fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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